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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,475	10/12/2001	Jeffrey C. Hawkins	21495-05940	9956

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EXAMINER	
LE, DUY K	

ART UNIT	PAPER NUMBER
2685	

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14

Please find below and/or attached an Office communication concerning this application or proceeding.

3

Office Action Summary	Application No.	Applicant(s)	
	09/976,475	HAWKINS ET AL.	
	Examiner	Art Unit	
	Duy K Le	2685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-32 is/are pending in the application.

4a) Of the above claim(s) 12-19,21-28,31 and 32 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-11,20,29 and 30 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 9,10,11,12,13.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-11, 20, 29, and 30, drawn to an integrated PDA to respond to different applications when the lid is open and certain buttons are activated, classified in class 455, subclass 556.1, 556.2, 557.

II. Claims 13-19, drawn to an integrated PDA to respond to different presses of the power button that activates different modes/functions, classified in class 455, subclass 575.1.

III. Claims 12 and 21-25, drawn to an integrated PDA to provide incoming call indication and response based on the lid condition, classified in class 455, subclass 415, 567.

IV. Claims 26-28, drawn to an integrated PDA to provide call termination/disconnection with certain time interval, classified in class 455, subclass 566 or class 379, subclass 207.02, 207.03.

V. Claims 31-32, drawn to an integrated PDA to provide call notification, classified in class 455, subclass 414.1, 567.

2. Inventions I, II, III, IV, and V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are distinct, each from the other because of the following reasons: Invention I has utility such as an integrated PDA with different activation of different buttons and

applications, when the lid is open; Invention II has separate utility such as different presses of the power button activates different modes/functions; Invention III has separate utility such as providing incoming call indication and response based on the lid condition; Invention IV has separate utility such as call termination/disconnection with certain time interval; and Invention V has separate utility such as call notification.

3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, III, IV, or V, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Daniel R. Brownstone on June 15, 2004, a provisional election was made with traverse to prosecute the invention of Hawkins, claims 1-11, 20, 29, and 30 (Group I). Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-19, 21-28, and 31-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 7, 8, 20, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen (U.S. Patent 5,797,089).

As to claim 1, the Nguyen reference discloses a method for operating a personal digital assistant (PDA), the PDA including a lid, a power button, a processor, a memory, and a plurality of applications stored in the memory (see Col. 3, line 56 to Col. 4, line 63, and Figures 2 and 3), the method comprising:

responsive to the lid being opened, activating the device and executing by the processor a first application stored in the memory of the PDA (see Col. 6, lines 58 to Col. 7, line 3); and

responsive to activation of the power button, activating the device and executing by the processor a second application stored in the memory of the PDA (see Col. 7, lines 4-12).

As to claim 2, the Nguyen reference discloses the method of claim 1, wherein the first application and the second application are the same application (at steps 67 and 75, with power on the telephone powered on, the PDA passes the telephone number to the telephone unit for wireless telephone function (see Col. 6, line 66 to Col. 7, line 3, Col. 7, lines 17-21, and Figure 4)).

As to claim 7, the Nguyen reference discloses a method for operating a personal digital assistant (PDA), the PDA including a lid, at least one application button, a processor, a memory, and a plurality of applications stored in the memory (see Col. 3, line 56 to Col. 4, line 63, and Figures 2 and 3), the method comprising:

responsive to the lid being opened, activating the device and executing by the processor a first application stored in the memory of the PDA (see Col. 6, lines 58 to Col. 7, line 3); and

responsive to activation of one of the application buttons, activating the device and executing by the processor a second application stored in the memory of the PDA, the second

application associated with the activated application button (see Col. 5, lines 49-60 and Col. 7, lines 13-21).

As to claim 8, the Nguyen reference discloses the method of claim 7, wherein the PDA additionally includes a power button (see Figure 2), the method further comprising:

responsive to activation of the power button, activating the device and executing by the processor a second application stored in the memory of the PDA (see Col. 7, lines 4-12).

As to claim 20, the Nguyen reference discloses a method for operating a personal digital assistant (PDA), the PDA including a lid, a wireless communication module, a processor, a memory, and a plurality of applications stored in the memory (see Col. 3, line 56 to Col. 4, line 63, and Figures 2 and 3), the method comprising:

determining that the lid has been opened (see Col. 6, lines 45-49 and lines 58-61);

responsive to the lid having been opened:

turning on the PDA (see Col. 7, lines 4-12); and

launching one of the plurality of applications (see Col. 7, lines 4-12).

As to claim 29, Figures 2 and 3 in Nguyen show an integrated personal digital assistant (PDA) (10) comprising:

a base (22) (see Col. 3, lines 56-63 and Col. 4, lines 7-16);

a processor (43), for executing software instructions on the PDA (see Col. 4, line 59 to Col. 5, line 9);

a memory (41, 46), for storing software instructions to be executed by the processor (see Col. 4, line 59 to Col. 5, line 9);

a plurality of applications stored in the memory (see Col. 4, line 59 to Col. 5, line 9),

a lid (21), coupled to the base (22), for activating the device when opened, and causing the processor to execute a first application stored in the memory (see Col. 6, lines 58 to Col. 7, line 3); and

a power button (25), coupled to the base, for activating the device when pressed, and causing the processor to execute a second application stored in the memory (see Col. 7, lines 4-12).

As to claim 30, the Nguyen reference discloses a computer program product stored on a computer readable medium for operating an integrated personal digital assistant (PDA) device (see Col. 4, line 59 to Col. 5, line 9), the computer program product controlling a processor coupled to the medium to perform the operations of:

responsive to a lid of the device being opened, activating the device and executing a first application stored in the memory of the device (see Col. 6, lines 58 to Col. 7, line 3); and

responsive to activation of the power button, activating the device and executing a second application stored in the memory of the device (see Col. 7, lines 4-12).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,797,089 to Nguyen in view of Takahashi (U.S. Patent 6,662,244).

As to claim 3, the Nguyen reference discloses the method of claim 1. However, it does not disclose the PDA additionally includes a jog rocker, and further comprising: responsive to activation of the jog rocker, activating the device and executing by the processor a second application stored in the memory of the PDA. The Takahashi reference teaches the PDA additionally includes a jog rocker, and further comprising: responsive to activation of the jog rocker, activating the device and executing by the processor a second application stored in the memory of the PDA (see Col. 3, lines 27-30, Col. 6, lines 1-3, Col. 7, lines 8-28, and Figure 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Nguyen wherein the PDA additionally includes a jog rocker, and further comprising: responsive to activation of the jog rocker, activating the device and executing by the processor a second application stored in the memory of the PDA, as taught by Takahashi, in order to control the input/display mode by means of a jog dial.

As to claim 4, the Nguyen reference discloses a method for operating a personal digital assistant (PDA), the PDA including a lid, a processor, a memory, and a plurality of applications stored in the memory, the method comprising:

responsive to the lid being opened, activating the device and executing by the processor a first application stored in the memory of the PDA; and

However, it does not disclose the PDA includes a jog rocker, and further comprising: responsive to activation of the jog rocker, activating the device and executing by the processor a second application stored in the memory of the PDA. The Takahashi reference teaches the PDA additionally includes a jog rocker, and further comprising: responsive to activation of the jog

rocker, activating the device and executing by the processor a second application stored in the memory of the PDA (see Col. 3, lines 27-30, Col. 6, lines 1-3, Col. 7, lines 8-28, and Figure 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Nguyen wherein the PDA additionally includes a jog rocker, and further comprising: responsive to activation of the jog rocker, activating the device and executing by the processor a second application stored in the memory of the PDA, as taught by Takahashi, in order to control the input/display mode by means of a jog dial.

As to claim 5, Nguyen-Takahashi discloses the method of claim 4, wherein the PDA further includes at least one application button (Takahashi: see Figure 9), the method further comprising:

responsive to activation of one of the application buttons, activating the device and executing by the processor a second application stored in the memory of the PDA, the second application associated with the activated application button (Takahashi: see Col. 7, lines 18-28).

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,797,089 to Nguyen in view of Takahashi (U.S. Patent 6,662,244) and further in view of Boesen (U.S. Patent Application Publication 2001/0027121).

As to claim 6, Nguyen-Takahashi discloses the method of claim 4. However, it does not disclose the plurality of applications stored in the memory includes an alarm application, and the method further comprises: responsive to a signal from the alarm application, activating the device and executing by the processor the alarm application. The Boesen reference teaches the plurality of applications stored in the memory includes an alarm application, and the method

further comprises: responsive to a signal from the alarm application, activating the device and executing by the processor the alarm application (see page 2, col. 2, paragraph [0046]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Nguyen-Takahashi wherein the plurality of applications stored in the memory includes an alarm application, and the method further comprises: responsive to a signal from the alarm application, activating the device and executing by the processor the alarm application, as taught by Boesen, in order to notify a person of appointments or incoming messages.

6. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,797,089 to Nguyen in view of Boesen (U.S. Patent Application Publication 2001/0027121).

As to claim 9, the Nguyen reference discloses a method for operating a personal digital assistant (PDA), the PDA including a lid, a processor, a memory, and a plurality of applications stored in the memory (see Col. 3, line 56 to Col. 4, line 63, and Figures 2 and 3), the method comprising: responsive to the lid being opened, activating the device and executing by the processor a first application stored in the memory of the PDA (see Col. 6, lines 58 to Col. 7, line 3).

However, it does not disclose the plurality of applications stored in the memory includes an alarm application, and the method further comprises: responsive to a signal from the alarm application, activating the device and executing by the processor the alarm application. The Boesen reference teaches the plurality of applications stored in the memory includes an alarm application, and the method further comprises: responsive to a signal from the alarm application,

activating the device and executing by the processor the alarm application (see page 2, col. 2, paragraph [0046]).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Nguyen wherein the plurality of applications stored in the memory includes an alarm application, and the method further comprises: responsive to a signal from the alarm application, activating the device and executing by the processor the alarm application, as taught by Boesen, in order to notify a person of appointments or incoming messages.

As to claim 10, Nguyen-Boesen discloses the method of claim 9, wherein the PDA additionally includes a power button (Nguyen: see Figure 2), the method further comprising:

responsive to activation of the power button, activating the device and executing by the processor a second application stored in the memory of the PDA (Nguyen: see Col. 7, lines 4-12).

As to claim 11, Nguyen-Boesen discloses the method of claim 9, wherein the PDA further includes at least one application button (Nguyen: see Col. 3, line 56 to Col. 4, line 63, and Figures 2 and 3), the method further comprising:

responsive to activation of one of the application buttons, activating the device and executing by the processor a second application stored in the memory of the PDA, the second application associated with the activated application button (Nguyen: see Col. 5, lines 49-60 and Col. 7, lines 13-21).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Ewing et al. (U.S. Patent 6,611,697) discloses accessory for providing light based functionality to a mobile communications device.

b. Chhatriwala et al. (U.S. Patent 6,725,060) discloses method and apparatus for conserving power in an integrated electronic device that includes a PDA and a wireless telephone.

c. Maupin et al. (U.S. Patent 6,477,482) discloses power button controlled diagnostic mode for an information appliance.

d. Pinard et al. (U.S. Patent Application Publication 2003/0123627 A1) discloses palm PC dockable phone.

e. Ditzik et al. (U.S. Patent 5,983,073) discloses modular notebook and PDA computer systems for personal computing and wireless communications.

f. Kim (U.S. Patent 6,397,078) discloses combined mobile telephone and personal digital assistant.

g. Lai et al. (U.S. Patent Application Publication 2002/0086702 A1) discloses personal digital assistant with a multi-functional flip cover.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duy K Le whose telephone number is 703-305-5660. The examiner can normally be reached on 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward F Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Duy Le
June 17, 2004

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